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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,705	03/17/2006	Yoshitaka Tomigahara	2006_0367A	5356

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Washington, DC 20005-1503

EXAMINER
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ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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07/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



<b>Office Action Summary</b>	<b>Application No.</b> 10/572,705	<b>Applicant(s)</b> TOMIGAHARA ET AL.	
	<b>Examiner</b> REBECCA L. ANDERSON	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22,25,26,28,30,31,34,35,37 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) 4-14,19-22,25,26,28,30,31,35 and 40-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,15,16 and 34-39 is/are rejected.
- 7) ☒ Claim(s) 1-3,15-18,34,37 and 39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



### **DETAILED ACTION**

Claims 1-22, 25, 26, 28, 30, 31, 34, 35, 37, and 39-42 are currently pending in the instant application. Claims 1-3, 15-18, 34, 37 and 39 are objected. Claims 1-3, 15, 16, 34, 37 and 39 are rejected. Claims 4-14, 19-22, 25, 26, 28, 30, 31, 35, and 40-42 are withdrawn from consideration as being for non-elected subject matter.

### ***Election/Restrictions***

Applicant's election of Group II, claims 1-3, 15-18, 34, 37 and 39 and the further election of the species 3a-32 in the reply filed on 13 May 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

As per MPEP 803.02, the examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species is considered allowable.

Therefore, according to MPEP 803.02:

Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable \*\*, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. the elected species shall be rejected, and claims to the nonelected species will be held withdrawn from further consideration.

As the elected species has been found allowable, the search and examination has been extended to include the compound:

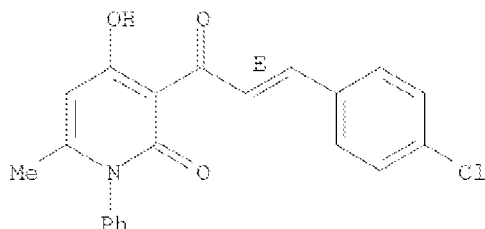


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RN 16862-54-7 CAPLUS

CN 2(1H)-Pyridone, 3-(p-chlorocinnamoyl)-4-hydroxy-6-methyl-1-phenyl-, (E)-  
(8CI) (CA INDEX NAME)

Double bond geometry as shown.



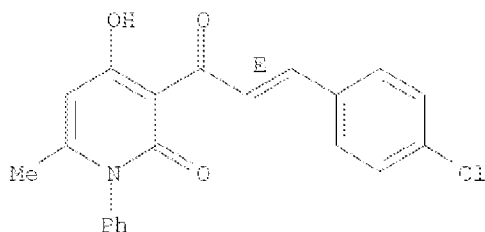
, which has been found not allowable.

**Claims 1-3, 15-18, 34, 37 and 39 have been examined to the extent that they are readable on the elected embodiment, the elected species of example 3a-32 and the additional species of the compound of:**

RN 16862-54-7 CAPLUS

CN 2(1H)-Pyridone, 3-(p-chlorocinnamoyl)-4-hydroxy-6-methyl-1-phenyl-, (E)-  
(8CI) (CA INDEX NAME)

Double bond geometry as shown.



. Since the elected embodiment is not allowable, subject matter not embraced by the elected embodiment is therefore withdrawn from further consideration. Claims 4-14, 19-22, 25, 26, 28, 30, 31, 35, and 40-42 are therefore withdrawn from consideration as being for non-elected subject matter. It has been determined that the entire scope claimed is not patentable.



***Claim Objections***

Claims 1-3, 15-18, 34, 37 and 39 are objected to because of the following informalities: Specifically the claims end in a semi-colon instead of a period. Appropriate correction is required.

Claims 1-3, 15-18, 34, 37 and 39 are objected to as containing non-elected subject matter. Claims 1-3, 15-18, 34, 37 and 39 presented drawn solely to the elected embodiment identified supra would overcome this objection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 15, 16, 34, 37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Vul'fson (abstract).

Vul'fson discloses the compound, for example, of formula IV wherein R is Ph and R1 is p-Cl, specifically:

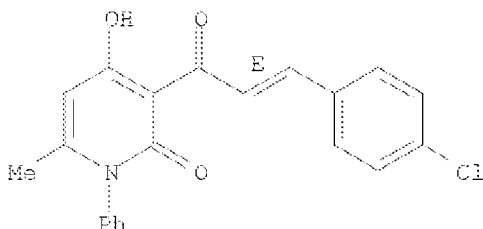


Art Unit: 1626

RN 16862-54-7 CAPLUS

CN 2(1H)-Pyridone, 3-(p-chlorocinnamoyl)-4-hydroxy-6-methyl-1-phenyl-, (E)-  
(8CI) (CA INDEX NAME)

Double bond geometry as shown.



which corresponds to the 2(1H)-pyridinone compound as claimed in claim 16 , for example, wherein (Xg)p is not present as p is 0; q is 1 and Yg is X6 which is a Ma-group wherein Ma is a halogen atom; Ta is an Mc-group wherein Mc is a Md-Rd' group wherein Rd' is a bond and Md is a phenyl group; Qa is a hydroxyl group ; Ka is a hydrogen atom and; La is a C1 alkyl group. The compound in the Vul'fson reference corresponds to the formula (I) in claims 1-3, 15, 34, 37 and 39 while, the preparation of formula IV wherein R is ph and R1 is p-Cl was in piperidine or in 10% aqueous NaOH and MeOH. Methanol corresponds to the inert carrier (defined in the instant specification to include pharmaceutically acceptable carriers) in the I type collagen gene transcription suppressing composition claims 1-3, 15, 34, 37 and 39. The intended use in the preamble as a I type collagen gene transcription suppressing composition does not result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Additionally, the intended use has not been given patentable weight because the recitation occurs in the preamble. A preamble is not generally accorded any patentable



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weight where it merely recites the intended use of a structure and where the body of the claim does not depend on the preamble for completeness, but, instead, the structural limitations are able to stand alone.

In regards to the inert carrier, as can be seen by Schubert et al. (found on the enclosed PTO-892) methanol is considered a pharmaceutically acceptable organic solvent, see page 125 which states that the method uses pharmaceutically acceptable organic solvents and page 126 which discloses methanol as a solvent.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/  
Primary Examiner, AU 1626*

29 July 2009

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Rebecca Anderson  
Primary Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600